



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,702	06/24/2003	Roland Hahn	028811-21	7556

25570 7590 01/30/2007
ROBERTS, MLOTKOWSKI & HOBBS
P. O. BOX 10064
MCLEAN, VA 22102-8064

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
----------	--------------

1771

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/601,702

Applicant(s)

HAHN, ROLAND

Examiner

Daniel Zirker

Art Unit

1771.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-15,17-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7-11,15,17 and 19-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1771

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 15,17,19 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, in claims 15 and 17 the invention in each of these claims should not be directed to a "Sealing element" in the claim preamble, which is presently the case. In claim 19 the Examiner finds sections "c" and, most particularly, "b" to be confusing and suggests that it might be desirable if the same or very similar language presently used in closely related claim 20 be used in place of that presently found in these sections. In claim 26 "adhesion" is a misspelling of --adhesion--.
3. Claims 1,3,4,7-11,15,17, and 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE '399 as set forth in the relied upon Hahn et al US patent "translation" taken either individually, or in view of the Wacker publication, substantially for the reasons set forth in Paragraph No. 3 of Paper No. 041806, together with the following additional observations. With respect to the rejection based upon the primary reference taken individually the Examiner would like to take Official Notice that to provide a primer layer or its somewhat broader embodiment, an "intermediate adhesion layer" (the latter claimed by applicant) in the surface bonding art for the purpose of improving the bonding between, e.g. a silicone cement and an acrylate foam, is so well known as to not require the presence of a reference. Such an intermediate adhesion layer would be utilized in circumstances where two substrates could not be either

Art Unit: 1771

effectively or easily (e.g. the latter occurring in situations such as where curing of the adhesive was difficult or unduly long) adhered together. Alternatively, the Wacker trade publication is again relied upon for situations such as set forth in the second paragraph of page 2 of the reference wherein one of ordinary skill would be reminded that the use of intermediate adhesion layers such as primers would be desirable "if the bonded parts are to be subjected to temperature changes, damp conditions, tension, compression, shear, etc. Some porous substrates also require primers." Accordingly, one of ordinary skill would have more than ample motivation to use an intermediate adhesion layer such as applicant's preferred primer G 718 to adhere the desired surfaces to be bonded together, even in situations where one of the surfaces to be adhered is a porous foam. Finally, the issue of a crosslinked adhesive was addressed in the prior Action, to which applicant essentially responded only that the relied upon references did not teach it, which the Examiner had already acknowledged.

4. Claim 4 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 21 of copending Application No. 10/204,545. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the Examiner notes that the present pending claim of the application is directed to an adhesive tape and claim 21 of the '545 application is directed to a "Seal arrangement", and contains the sealing element inside instead of outside the "comprising" section, and also (perhaps most importantly) the pending application claims the acrylic foam instead of an acrylate cement as one of the self sticking adhesive surfaces, the Examiner still nevertheless believes that provisional

Art Unit: 1771

double patenting exists. Each of these differences are believed to be either minor distinctions for the purpose of obviousness double patenting, or obvious variations in the case of the two self sticking surfaces which use either an acrylate cement or an acrylate foam surface. .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday - Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571 - 272 - 1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/601,702

Page 5

Art Unit: 1771

Daniel Zirker
Primary Examiner
Art Unit 1771

A handwritten signature in black ink that reads "Daniel Zirker". The signature is written in a cursive style with a large, stylized 'D' and 'Z'.